

REMARKS

In the Office Action mailed October 22, 2009, claims 18-22, 50-54, 69, 76, 79 and 86 were pending. Claims 18-20, 22; 50-52, 54; 69; 76; 79; and 86 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0002590 by King et al. Claims 21,53 were rejected under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 by King et al. in view of U.S. Patent No. 5,341,505 by Whitehouse.

Claims 18, 50, 69, 76, 79, and 86 are amended to clarify that the standardized physical address used to deliver the message is linked to the electronic account. Claims 21 and 53 are also amended. Claims 92-94 are introduced.

Applicants respectfully traverse the rejection of Claims 18-20, 22; 50-52, 54; 69; 76; 79; and 86 under 35 U.S.C. § 102(e) as being anticipated by King.

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. Lewmar Marine Inc. v. Barient, Inc., 827 F.2<sup>nd</sup> 744, 747, 3 U.S.P.Q.2<sup>nd</sup> 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “*arranged as in the claim.*” Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2<sup>nd</sup> 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

First, Applicants respectfully assert that the U.S. Patent Publication No. 2002/0002590 by King et al. cannot, by itself, be prior art in reference to these claims. Applicants claim priority to their U.S. Provisional Patent Application No. 60/189,983 filed March 17, 2000. This date is before the filing date of the patent application by King cited above, which was filed on March 9, 2001. However, that King patent application claimed priority to U.S. Provisional Patent Application No. 60/188,006 filed March 9, 2000, eight days before the priority date for

Applicants' application. The relevance of this distinction is that utility patent applications claiming priority to provisional patent applications are treated as Continuations-in-Part in reference to the provisional patent applications in terms of their content. This is because these utility patent applications may, and often do, contain disclosure that is not present in the provisional patent applications that they claim priority to. Thus, disclosure in the utility application that is found in the provisional application has a priority date of the provisional application, and disclosure in the utility application that is not found in the provisional application has a priority date of the filing of the utility application. This is relevant in this case, since King's utility application contains substantial disclosure that was not present in their provisional application.

King fails to disclose, suggest, or teach *"receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user"*. Rather King receives messages containing physical addresses, and then determines the electronic account from the physical address:

[0007] Therefore, the present invention provides an e-mail system, an e-mail post office, and a method for forwarding e-mail, by using physical address information of the recipient and mapping that to a constant permanent e-mail address. According to one aspect of the present invention, an e-mail system is provided in which the transmitting host transmits the e-mail addressed to the recipient's physical address (e.g., home or work address). (Utility ¶ [0007])

The Subject invention relates to an electronic post office (USPS E-Box) that uses the physical address and NAME of the recipient to determine where to route electronic mail.

The following invention constitutes the construction of an electronic post office (E.Box) that relies primarily on physical addresses. The E.Box will utilize the physical address (street, P.O. Box, rural route and the like) and name of the

recipient to determine where to route electronic mail... Mailers who have physical addresses will be able to use them to send messages electronically by accessing the E-Box from any web browser...  
(Provisional Page 1, Summary of the Invention).

The King utility application may be read to include an electronic address in the message. But critically, that element is not disclosed in the provisional application, and is therefore not prior art in relation to the present application.

Furthermore, King teaches converting the non-standardized physical address to a standardized physical address BEFORE the message is sent (see ¶ [0023]). The physical address in the message is therefore standardized, and not non-standardized. This makes sense, since King utilizes physical addresses to identify recipients, and use of a standardized physical address would make this more robust. This element is missing for the King references.

Furthermore, the independent claims have been amended to clarify that the standardized physical address is linked to the electronic account, and that linked version of the standardized physical address is used to address messages that are to be physically delivered. Reference is made here to FIGs. 2-4, and 10-11C (the later for a delivery point identification key claimed in Claims 79 and 86). Thus, the standardized physical address utilized for addressing messages for physical delivery is typically not created from the non-standardized physical address in the message when received, or sent (as is the case in King – see ¶ [0023]), but rather, is retrieved utilizing the link in the account record. And, if the non-standardized and standardized physical addresses do not match, the standardized physical address can be returned to senders (see Claims 21 and 53). These elements are missing from the King references.

Claimed elements are missing from the relevant King references and the elements are not arranged as in the claims. Applicants therefore respectfully submit that a *prima facie* case of

anticipation has not been established, that this rejection of these claims is improper, and requests that it be withdrawn.

Applicants respectfully traverse the rejection of Claims 21 and 53 under 35 U.S.C. § 103(a) as being unpatentable by King in view of Whitehouse. Applicants incorporate by reference their arguments above in relation to the rejection under 35 U.S.C. § 102(e) in view of King. The elements missing in the King reference above are not provided by Whitehouse.

Furthermore, the claims are amended to clarify that the sender of the message is informed of the standardized physical address. This was previously implied, but is made specific here in order to better distinguish these claims from Whitehouse. Whitehouse essentially discloses a query response method of converting five digit Zip codes to nine digit Zip codes. Thus, the software that would use this system sends a request with a physical address and a 5 digit Zip code, and receives in response a 9 digit Zip code (or an error). There is no reason to believe that if combined with King, the 9 digit Zip code would ever be returned to the sender of the message. This is not disclosed in Whitehouse.

Applicants therefore respectfully submit that a *prima facie* case of obviousness has not been established for these claims, that this rejection of these claims is improper, and requests that it be withdrawn.

Applicants believe that the above-identified application is now in condition for allowance and such action is respectfully requested.

If the Examiner has any questions regarding this application or this response, the Examiner is requested to telephone the undersigned at 775-586-9500.

Respectfully submitted,  
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